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Thomas E. Ward III

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ROPES & GRAY LLP

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PENG, FRED H

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,811	<b>Applicant(s)</b> WARD ET AL.	
	<b>Examiner</b> FRED PENG	<b>Art Unit</b> 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/01/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 02/25/2009 have been fully considered but they are not persuasive.

Applicant argues on page 20 of Remarks that Hendricks shows selecting, at the user equipment, one of a number of advertisements (see Hendricks, paragraph 136), but the contents of the advertisements themselves are not modified or customized at the user equipment. Since all of the claim limitations of applicants' claims 1, 39, and 57 are not shown or suggested by Schein and Hendricks, either alone or in combination, there is no prima facie case of obviousness.

The Examiner respectfully disagrees with applicant's arguments. Hendricks discloses a primary advertisement can be replaced by an alternative advertisement by tuning to a separate channel; and the act to tune to a different channel at the user equipment to receive an alternative advertisement itself is considered to modify the contents of advertisements (Para 23; Para 136 lines 1-13).

Applicant further argues on pages 21-22 of Remarks that the portions of Ellis cited by the Examiner do not show or suggest forming a customized advertisement by overlaying, at user equipment, a locally retrieved subset of television schedule information onto a portion of received advertisement information, as recited in the applicant's claims 20 and 58.

The Examiner also disagrees with applicant's arguments. Ellis discloses the received and stored television schedule information as shown in FIG.43A is overlaying, through a video overlay device at a user equipment, over a commercial advertisement when requested by the user through an icon (Para 230 line 17- last line), thus form a modified advertisement with overlaid program guide.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19, 39-57 and 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) in view of Hendricks et al (US 2004/0111742).

Regarding Claims 1, 39 and 57, Schein discloses a EPG system (FIG.1, FIG.16A) with corresponding method and a computer readable medium (FIG.1, 18) having stored thereon a set of instructions for displaying an advertisement (FIG.16A, 524, 526, 528), when executed by a microprocessor (FIG.1, 16), cause the microprocessor to perform the step of:

storing, local to a user equipment, TV schedule information in a first database (Para 6 lines 9-14; Para 29);

receiving advertisement information and stored in second database (Para 7 lines 1-5; Para 50).

Inherently retrieving a first subset of the stored television schedule information from the database for display;

displaying, in a schedule guide region of a screen, a plurality of television schedule listings comprising a second subset of the stored television schedule information; and displaying the advertisement in a area of the screen that is outside the schedule guide region (FIG.16A; Para 133 lines 20-27; advertisement 528 is outside of a second subset of the stored television schedule information 508).

Schein is silent about modifying, at a user equipment, a portion of the advertisement information to include a first subset of the stored TV schedule information to form a modified advertisement; wherein the first subset of stored television schedule information is different from the second subset of stored television schedule information.

In an analogous art, Hendricks discloses modifying, at a user equipment, a portion of the advertisement information to include a first subset of the stored TV schedule information to form a

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modified advertisement (Para 23; Para 136 lines 1-13; modify, at a user equipment, a portion of the advertisement information based on viewer's viewing history, a first subset of the stored TV schedule information).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's method to include modifying, at a user equipment, a portion of the advertisement information to include a subset of the stored TV schedule information to form a modified advertisement, as taught by Hendricks with the advantage of targeting the specific viewers.

Regarding Claim 2, Schein and Hendricks both disclose method is performed in substantially real time (Schein discloses EPG with advertisement in real time in response to user command while Hendricks discloses switching alternate advertisement while viewer is watching, Para 136 lines 11-13).

Regarding Claims 3, 13-14 and 49-50, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claims 4-5 and 40-42, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129, Para 133 lines 21-25).

Regarding Claims 6 and 43, Schein further discloses storing a program description and combining a portion of the received advertisement with stored program description (FIG.16A).

Regarding Claims 7 and 44, Schein further discloses storing a program telecast time and combining a portion of the received advertisement with stored program telecast time (FIG.16A).

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Regarding Claims 8, 16, 45 and 52, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11, Para 144 lines 8-12).

Regarding Claims 9 and 46, Hendricks further discloses storing an info related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location (Para 208).

Regarding Claims 10 and 47, Schein further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Para 128).

Regarding Claims 11-12 and 48, Schein also discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

Regarding Claims 15, 17, 51 and 53, Schein further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info and display more detail info related to the selected info and selected advertisement (FIG.1, 40; Para 95; Para 133).

Regarding Claims 18-19 and 54, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (FIG.11, 230; FIG.18A; FIG.19A; Para 96).

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Regarding Claim 55, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 56, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129, Para 133 lines 21-23).

Regarding Claims 60-61, Schein further discloses replacing a text or graphical portion of the received advertisement information with the stored television schedule information (FIG. 16A; Para 133 lines 20-26; Para 134; advertisements area 524, 528 can be used for programs related promotion).

3. Claims 20-23, 26-27, 29-38 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) in view of Ellis et al (US 2008/0184315).

Regarding Claims 20 and 58, Schein discloses a method and a computer readable medium having stored thereon a set of instructions for displaying an advertisement, when executed by a microprocessor, cause the microprocessor to perform the step of:

storing advertisement info in a 2nd database (Para 50).

storing television schedule information in a first database (Para 29);

displaying, in a schedule guide region of a screen, a plurality of television schedule listings comprising a second subset of the stored television schedule information; and displaying the advertisement in a area of the screen that is outside the schedule guide region (FIG. 16A; Para 133 lines 20-27; advertisement 528 is outside of a second subset of the stored television schedule information 508).

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Schein is silent about overlaying, at a user equipment, a first subset of television schedule information from the first database onto a portion of the advertisement information from the second database to form a modified advertisement.

In an analogous art, Ellis discloses overlaying, at a user equipment, a first subset of television schedule information from the first database onto a portion of the advertisement information from the second database to form a modified advertisement (Para 230 line 17-last; the received and stored television schedule information as shown in FIG.43 is overlaying, at a user equipment, over a commercial advertisement when requested by the user, thus form a modified advertisement).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include overlaying, at a user equipment, a first subset of television schedule information from the first database onto a portion of the advertisement information from the second database to form a modified advertisement, as taught by Ellis so more targeted advertisement can be achieved.

Regarding Claims 21-23, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129; Para 133 lines 21-25).

Regarding Claims 26 and 34, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11; Para 144 lines 8-12).

Regarding Claim 27, Schein further discloses storing schedule info step comprising storing a geographical location (Para 119 lines 1-11).



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Regarding Claims 29 and 30, Schein further discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A; Para 134 lines 4-9).

Regarding Claims 31 and 32, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Regarding Claim 33, Schein further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (FIG.1, 40).

Regarding Claim 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

Regarding Claim 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para 133 lines 21-26).

Regarding Claim 37, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (Para 96).

Regarding Claim 38, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

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4. Claims 24-25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 20 above, and further in view of Coleman et al (US 5,844,620).

Regarding Claim 24, Schein discloses storing a program description but is silent about overlaying the stored program description onto a portion of the stored advertisement information.

In an analogous art, Coleman discloses overlaying the stored program description onto a portion of a programming which could be an advertisement (FIG.6; Col 5 lines 22-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Schein and Ellis to include overlaying the stored program description onto a portion of the stored advertisement information, as taught by Coleman without interruption of existing programming.

Regarding Claim 25, Coleman further discloses overlaying the stored program telecast time onto a portion of the stored advertisement information (FIG.6, 230, 232, 234).

Regarding Claim 28, Coleman further discloses overlaying the stored info related to a TV viewer onto a portion of the stored advertisement information (Col. 4 lines 13-24; the related viewer information is part of EPG).

5. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Hendricks et al (US 2004/0111742) as applied to claim 1 above, and further in view of Coleman et al (US 5,844,620).

Regarding Claim 59, Schein and Hendricks are silent about overlaying the stored program description onto the received advertisement information.

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In an analogous art, Coleman discloses overlaying the stored program description onto a received programming which could be an advertisement (FIG.6; Col 5 lines 22-25).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Schein and Ellis to include overlaying the stored program description onto a received advertisement information, as taught by Coleman without interruption of existing programming.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:30-19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fhp

/Joseph P. Hirl/  
Supervisory Patent Examiner, Art Unit 2426  
June 6, 2009